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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,409	10/17/2000	Hans-Peter Wild	357153/0004	3320
26610 7590 09/28/2010 STROOCK & STROOCK & LAVAN LLP 180 MAIDEN LANE NEW YORK, NY 10038				
EXAMINER				
TRUONG, THANH K				
ART UNIT		PAPER NUMBER		
3721				
MAIL DATE		DELIVERY MODE		
09/28/2010		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANS-PETER WILD and EBERHARD KRAFT

Appeal 2010-002522
Application 09/690,409
Technology Center 3700

Before JOHN C. KERINS, MICHAEL W. O'NEILL and FRED A.
SILVERBERG, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Hans-Peter Wild and Eberhard Kraft (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 7, 9 and 11-14, all of the claims currently pending in the application.² We have jurisdiction under 35 U.S.C. § 6(b) (2002). We AFFIRM-IN-PART.

An oral hearing in connection with this appeal was held on September 16, 2010, with Steven B. Pokotilow, Esq., appearing on behalf of Appellants.

THE INVENTION

Appellants' claimed invention is to a method and apparatus for applying straw packages onto foil bags. Claims 7 and 13, reproduced below, are illustrative of the claimed subject matter:

7. A method of attaching a straw package to a foil bag having a triangular cross section, the method comprising:

providing a plurality of foil bags having a base and a first side wall comprising a first film and a second side wall comprising a second film, the first wall being connected to the second wall at an acute angle therewith, the first film including a plurality of first side edges overlapping and adhered to a plurality of second side edges of the second film, the first film having a first top edge connected to a second top edge of the second film, the base being connected to a bottom edge of the first film and to a bottom edge of a second film; wherein the foil bags are constructed to stand with the base located toward the bottom of the foil bag;

² This application was subject to a prior appeal directed to claims 1-6, which have been canceled from the application. A copy of the decision can be found in the prosecution file history of the underlying application.

providing a plurality of straw packages having an adhesive thereon and a cover strip covering the adhesive;

positioning each of the foil bags on a conveyor belt such that the foil bag lies on the conveyor belt on the first side wall, so that the second side wall is at an acute angle with the conveyor belt;

removing the cover strip from the plurality of straw packages and exposing the adhesive;

providing a lever having a depressing arm and a pivoting arm;

rotating the pivoting arm of the lever to displace the depressing arm downward toward the conveyor belt to apply one straw package onto the second side wall at an acute angle to the conveyor belt such that the adhesive of the straw package contacts the second side wall.

13. An apparatus for applying straw packages onto bags having a first rectangular film piece connected to a second rectangular film piece along three edges thereof, the foil bag also having a base connected to a bottom edge of the first rectangular film piece and to a bottom edge of the second rectangular film piece such that the foil bag has a triangular cross section, the apparatus comprising:

a conveyor belt constructed and arranged to convey a plurality of bags;

a straw package supplying assembly for supplying a plurality of straw packages having an adhesive thereon;

a transfer assembly positioned above the conveyor belt,

the transfer assembly constructed and arranged to receive a plurality of straw packages from the straw package supply assembly,

the transfer assembly having a straw retaining member constructed and arranged to retain the straw packages at an acute angle to the conveyor belt such that the adhesive faces the conveyor belt, the transfer assembly also including a straw applying member having a depressing arm and a pivoting arm, wherein rotating the pivoting arm of the lever displaces the depressing arm downward toward the conveyor belt to displace a straw package away from the retaining member and to apply the straw package onto one of the plurality of bags.

THE REJECTIONS

The Examiner has rejected claims 7, 9 and 11-14 under 35 U.S.C. § 103(a) as being unpatentable over Geyssel (US 4,584,046, issued April 22, 1986) in view of Wild (US 4,572,758, issued February 25, 1986)

ISSUES

Whether the Examiner erred in concluding that the method and system for applying straw packages set forth in claims 7, 9, 11, 12 and 14 would have been obvious over Geyssel in view of Wild?

Whether the Examiner erred in concluding that the apparatus for applying straw packages set forth in claim 13 would have been obvious over Geyssel in view of Wild?

ANALYSIS

The Examiner found, in reaching the conclusion that the claims would have been obvious, that

. . . Geyssel clearly teaches and suggests that the apparatus and method discloses [sic] by Geyssel can accommodate the containers of any material and shapes (*packages, bottles, bags, etc., & packages, bottles or other objects*) and those containers can be placed on the conveyor in any desired angular position - in other words, the container can be placed on the conveyor from an upright position all the way down to laying with one side flat on the conveyor.

(Ans. 9).

Appellants note that all claims, with the exception of claim 13, are directed to a straw application process or system in which the bags to which the straws are to be applied are moved on a conveyor belt lying on their sides, and that Geyssel does not disclose, and would require substantial reconstruction and modification, in order to operate to apply straws to foil bags conveyed in a lying position. (Appeal Br. 26-27). We agree with Appellants that, contrary to the Examiner's interpretation, the Geyssel patent does not fairly teach or suggest a method or system for applying straws to packages that are conveyed with one side laying on the conveyor belt, so as to be in a lying position.

The Examiner's position quoted above, in particular the assertion that the containers in Geyssel can be placed on the conveyor "in any desired angular position - in other words . . . from an upright position all the way down to laying with one side flat on the conveyor", is based principally on language found in the Abstract and at column 2, lines 19-31, in Geyssel.

(Ans. 8-9). The Abstract notes that “[t]he applicator device (10) can be tilted about two perpendicular directions . . . in order that the drinking straws (11) can be secured in different directions and on variously inclined surfaces of the package (12).” (Geyssel, Abstract). The passage at column 2 of Geyssel essentially repeats that the applicator device can be tilted about two perpendicular axes, so as to be “tipped” in several directions, and discloses that the “applicator element can be placed in any desired angular position against the objects to which the articles are to be secured.” (Geyssel, col. 2, ll. 19-31).

Notwithstanding the relatively ambitious language appearing in the Geyssel patent, Geyssel never expressly discloses that the apparatus would be suitable for use in conveying packages lying on their sides (as is intimated by the Examiner), and being capable of applying straw packages to the exposed side surfaces of the packages. It is clear from viewing the drawings of the Geyssel apparatus, and Figures 1 and 9 in particular, that the usable range of tilting motion around axis 16 is quite limited. For example, in Figure 9, were the carrier 14 and applicator wheel 20 rotated clockwise any more than is actually shown in that figure, at least the lower of the forked arms 41 (see Fig. 7) would move downwardly relative to conveyor belt 13 to a position where it would essentially be useless, and both the lower part of the applicator wheel 20 and arm 41 would, at some fairly small angle β , appear to physically interfere with the conveyor belt 13.

Accordingly, we can not support the Examiner’s finding that Geyssel clearly teaches and suggests a method or system in which the containers may be placed on the conveyor *in any desired angular position*, that is, from an upright position all the way down to laying with one side flat on the

conveyor. Appellants have the better argument here, that substantial modification of the Geyssel apparatus would appear to be necessary in order to perform a method of applying straw packages to bags which are conveyed while lying on their side.

We will thus not sustain the rejection of claims 7, 9, 11, 12 and 14 as being unpatentable over Geyssel and Wild.

Claim 13 is an apparatus claim that does not positively recite the provision of bags. Accordingly, Appellants' arguments directed to the nonobviousness of providing a method or system of applying straw packages to bags lying on their sides are unavailing here.

Appellants' principal argument for the patentability of claim 13 is that the combined teachings of Geyssel and Wild do not disclose or suggest the claimed "transfer assembly . . . including a straw applying member having a depressing arm and a pivoting arm, wherein rotating the pivoting arm of the lever displaces the depressing arm downward toward the conveyor belt" to displace the straw package and apply it onto a bag. (Appeal Br., Claims Appendix, Claim 13). In support of their position, Appellants contend that:

Geyssel is directed to applying straws to the packages from the side rather than the top and does not teach and has no reason to suggest the use of a depressing arm that exerts a downward motion as claimed.

(Reply Br. 12).

Geyssel . . . does not teach or suggest any rotation of carrier 14 such that the straws are applied to the packages from the top using a downward moving arm

(Reply Br. 13).

[T]here is no teaching or suggestion in Geyssel that the carrier may be repositioned so that the wheel is suspended over the package.

(Reply Br. 14).

These arguments are unavailing as well. Claim 13 does not explicitly or implicitly require that the apparatus must apply the straws to the packages from the top, nor that the transfer assembly or straw retaining member be positioned such that it is suspended over the top of the package. Appellants appear to contend that the claim language requiring that the transfer assembly is to be positioned “above the conveyor belt” and that the depressing arm is displaced “downward toward the conveyor belt” necessitate that the claim be interpreted in that more restrictive manner.

While Appellants’ disclosed preferred embodiment applies the straws from the top, and has the transfer assembly positioned over the top of the package, we agree with the Examiner that to construe claim 13 so restrictively would amount to reading limitations from the Specification into the claims. The Examiner points out that, in the Geyssel apparatus as illustrated in Figure 1 (as well as in Figures 7-9), the transfer assembly or wheel 20 of carrier 14 is positioned at a higher elevation than is the conveyor belt, thus meeting the claim limitation that the transfer assembly be positioned “above [at a higher elevation than] the conveyor belt.” (Ans. 4).

The Examiner further maintains that the depressing arm 40, 41 of Geyssel is fully capable of being displaced toward the conveyor belt. (Ans. 11-12). That assertion is supported by viewing the Geyssel apparatus in the position illustrated in Figure 9. There, because the wheel is tilted to be at an acute angle to the conveyor belt, a person of ordinary skill in the art would

readily understand that, as arms 40, 41 are displaced away from wheel 20 to apply a straw to a container, the movement of the arms will have a downward component in the direction of the conveyor belt. Stated another way, the planes in which the movement of arms 40, 41 lie intersect the plane of the upper surface of the conveyor belt, and thus there is movement or displacement of the arms toward the conveyor belt. The claim as written does not require movement from directly atop the conveyor belt, nor perpendicular downward movement, as apparently is Appellants' position.

We are thus not persuaded of error in the Examiner's conclusion that the subject matter of claim 13 would have been obvious in view of Geyssel and Wild. The rejection of that claim will be sustained.

CONCLUSIONS

The Examiner erred in concluding that the method and system for applying straw packages set forth in claims 7, 9, 11, 12 and 14 would have been obvious over Geyssel in view of Wild; and the Examiner did not err in concluding that the apparatus for applying straw packages set forth in claim 13 would have been obvious over Geyssel in view of Wild.

DECISION

The decision of the Examiner to reject claims 7, 9, 11, 12 and 14 is REVERSED. The decision of the Examiner to reject claim 13 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

Appeal 2010-002522
Application 09/690,409

mls

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